

REMARKS

In the Office Action mailed on January 22, 2004, the Examiner rejected claims 1-30. Claims 5, 14, and 27 have been cancelled and claims 1, 9, 15, 21, and 28 have been amended by this Amendment and Response. Upon entry of the amendments, claims 1-4, 6-13, 15-26, and 28-30 will remain pending in the present application. Applicant respectfully requests reconsideration of the rejections and allowance of all pending claims.

First Rejection Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-27 as being unpatentable over the Van Boven et al. (hereinafter "Van Boven") reference, U.S. Pat. No. 5,807,052, in view of the Bernoni reference, U.S. Pat. No. 5,584,628. As noted above, claims 5, 14, and 27 have been cancelled by this response and claims 1, 9, 15, 21, and 28 have been amended.

Claims 1-4, 6-13, and 15-27 are patentable because the cited references do not disclose all of the recited features of the claims. In addition, the pending claims are patentable because there is nothing in either the Van Boven or the Bernoni references that suggests the desirability, and thus the obviousness, of combining the references.

I. Claims 1-4, 6-13, and 15-27 Are Patentable Because The Cited References Do Not Disclose All Of The Recited Features Of The Claims

Independent Claim 1

First, amended independent claim 1 is patentable because the cited references do not disclose all of the recited features of the claim. For example, the cited references do not disclose "a stemmed washer having a *spring washer portion* and...a retaining portion extending *inward from an outer perimeter* of the spring washer portion," as recited in amended independent claim 1. Furthermore, the cited references also fail to disclose "an internally threaded fastener having a peripheral flange, wherein the retaining portion of the stemmed washer extends *over the peripheral*

flange to retain the fastener in the stemmed washer,” also as recited in amended independent claim 1.

Neither cited reference, either alone or in combination, discloses these recited features of amended independent claim 1. Accordingly, claim 1 is patentable over the cited references. Claims 2-4 and 6-8 depend from amended independent claim 1, and are also patentable over the cited references.

Independent Claim 9

Amended independent claim 9 also is patentable because the cited references do not disclose all of the recited features of claim 9. Similarly to claim 1, the cited references do not disclose: “a washer portion...wherein the washer portion extends outwardly from the standoff portion at an acute angle relative to the standoff portion” and “a retaining portion extending inwardly from the washer portion to capture the peripheral extension of the threaded nut *between* the retaining portion and the washer portion,” as recited in claim 9.

Neither of the cited reference, either alone or in combination, discloses these recited features of amended independent claim 9. Accordingly, claim 9 is patentable over the cited references. Claims 10-13 depend from amended independent claim 9, and are also patentable over the cited references.

Independent Claim 15

In addition, the cited references do not disclose “a washer portion extending outward from the standoff portion at an angle” and “a retaining portion extending inward from an outer perimeter of the washer portion to form a cavity between the washer portion and the retainer portion to retain the fastener and to enable the fastener to rotate relative to the base,” as recited in claim 15.

As above, neither cited reference discloses these recited features of amended independent claim 15, either alone or in combination. Accordingly, claim 15 is patentable over the cited

references. Claims 15-20 depend from amended independent claim 15, and are also patentable over the cited references.

Independent Claim 21

Finally, amended independent claim 21 also is patentable because the cited references do not disclose: “A method for making a fastener assembly, the method comprising:...forming a base with a standoff portion and a washer portion extending outward from the standoff portion *at an acute angle*...and plastically deforming the washer portion *radially inward* to form a skirt portion to retain the fastener in assembly with the base.”

The cited references, either alone or in combination, do not disclose these recited features. Accordingly, claim 21 is patentable over the cited references. Claims 22-27 depend from amended independent claim 21, and also are patentable over the cited references.

II. The Claims are Patentable Because There Is No Suggestion to Combine The References

In addition, the pending claims are patentable because there is nothing in either the Van Boven or the Bernoni references that suggests the desirability, and thus the obviousness, of combining the references. When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Van Boven sets forth an arrangement that *already retains* a fastener in a manner quite different from the structure claimed. Thus, the Van Boven reference does not need to be modified by Bernoni to retain the fastener. The Van Boven reference discloses a pre-assembled workpiece 100 that comprises a sleeve member 120 and a fastener member 110. *See* Van Boven, col. 2, lines 55-58. “The fastener member 110 has a threaded shank portion 112 and a head 114,

and is *retainably* disposed through the sleeve member 120.” Van Boven, col. 3, lines 58-60 (Emphasis added). Thus, the motivation to combine the references provided by the Examiner is not supported by the prior art. As noted above, the Examiner stated in the Office Action that: “At the time the invention was made, the person of ordinary skill in the art would have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining the fastener in Van Boven.” However, since the Van Boven reference already discloses a means for retaining the fastener member 110 within the sleeve member 120, there is no reason to look to the Bernoni reference for a means of retaining the fastener 110.

Indeed, this combination would make the retaining features of Van Boven *entirely superfluous*, and *unworkable*. Specifically, the sleeve member 120 has a protuberance 122 that protrudes from an inner surface of the sleeve member 120. *See* Van Boven, col. 2, lines 52-56. The fastener 110 has a corresponding protruding shank member, or protuberance, 116 that is located between the threaded end portion 112 and the head 114. *See* Van Boven, col. 4, lines 57-62. The radial surface 118 of the shank rib member 116 engages the radial surface 123 of the sleeve member 122 to prevent removal of the fastener 110 from the sleeve member 120 in one direction. *See* Van Boven, col. 2, lines 64-67. The flanged portion 115 of the head 114 engages the first end of the sleeve member 120 to prevent the fastener 110 from being inserted completely through the sleeve member 120 in the opposite direction. *See* Van Boven, col. 2, line 67-col. 3, line 2. Thus, the fastener 110 of Van Boven is retained within the sleeve member 120 without the need to look to the Bernoni reference for a means for retaining the fastener 110.

In conclusion, the cited references simply do not suggest the desirability of modifying Van Boven in view of Bernoni. In fact, using the method of Bernoni to retain the fastener 110 would render it unsatisfactory for its intended purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *See Also* MPEP § 2143.01, pg. 2100-127. In Bernoni, the head 13 of a bolt 11 is retained within an annular seat 14 (represented by the Examiner as a retaining

skirt) of a bush 12. *See* Bernoni, Fig. 3. As a result, the annular seat 14 severely limits the axial movement of the head 13 of the bolt 11, and thus the bolt 11. *See* Bernoni, Fig. 3. Therefore, if the radial flange 124 of the sleeve member 120 of Van Boven was modified to retain the head 114 of the fastener 110 as per Bernoni, the axial movement of the fastener 110 relative to the sleeve member 120 would be severely limited.

On this precise point, the Van Boven reference states that:

According to this aspect of the invention, the fastener 110 is *axially* positionable relative to the first work piece so that the fastener 110 does not protrude beyond the mounting surface 106 of the first workpiece 101 during mounting and alignment. The fastener 110 is subsequently *axially* extendable into the bore 14 of the second workpiece 10. (Van Boven, col. 5, lines 3-12).
(Emphasis added).

Thus, by retaining the head 114 of the fastener 110 of Van Boven as per Bernoni, the fastener 110 would not be axially positionable, and would therefore be rendered unsatisfactory for its intended purpose. Accordingly, at the time the invention was made, a person of ordinary skill in the art would not have recognized the retaining skirt as disclosed in Bernoni as an optimal means of retaining the fastener in Van Boven.

For all of these reasons, claims 1-4, 6-13, and 15-26 are patentable over the cited references. Withdrawal of the rejection and allowance of the pending claims are respectfully requested.

Second Rejection Under 35 U.S.C. § 103

Claims 28-30 are rejected under 35 U.S. C. 103(a) as being unpatentable over Van Boven in view of Bernoni and further in view of applicant's admitted prior art (APA). For the reasons provided above, claims 28-30 are patentable because there is no suggestion or motivation to combine the references. Furthermore, the teaching or suggestion to make the claimed

combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, the Examiner is improperly relying on the applicant's disclosure to provide the motivation to combine.

In addition, amended independent claim 28 is patentable because the cited references do not disclose all of the recited features of the claim. For example, the cited references do not disclose "a stemmed washer having...a spring washer portion...and a retaining portion *forming a cavity* with the spring washer portion" and "an internally threaded fastener retained in assembly with the stemmed washer by the retaining portion and the spring washer portion."

For all of these reasons, claim 28 is patentable over the cited references. Claims 29 and 30 depend from claim 28. Accordingly, claims 29 and 30 also are patentable over the cited references. Withdrawal of the rejection and allowance of the pending claims are respectfully requested.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,



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